

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: May 22, 2003

Opposition No. 91/151,445
Cancellation No. 92/040,955

ROLLER DERBY SKATE CORPORATION

v.

BAUER NIKE HOCKEY INC.

(as consolidated)

Andrew P. Baxley, Interlocutory Attorney:

In view of filings that became associated with the above-captioned proceeding files following the issuance of the Board's May 14, 2003 order in Opposition No. 151,445, that order is hereby vacated.

Plaintiff's motion (filed December 6, 2002) to extend to December 14, 2002 its time to respond to defendant's first set of interrogatories, first set of requests for production and first set of requests for admission in Cancellation No. 40,955 is hereby granted as conceded. See Trademark Rule 2.127(a).

This case now comes up for consideration of (1) plaintiff's motion (filed March 10, 2003) to extend

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discovery in Opposition No. 151,445;¹ and (2) plaintiff's motions (both filed April 18, 2003) to extend testimony periods in both of the above-captioned proceedings. Defendant has filed a combined brief in opposition to plaintiff's motions in Opposition No. 151,445.

In support of its motion to extend discovery in Opposition No. 151,445, plaintiff contends that its attorney was in the process of preparing discovery requests and that its attorney needs additional time to consult with it in preparation thereof. Accordingly, plaintiff asks that the discovery period be extended by one month.

In opposition, defendant contends that plaintiff has failed to show detailed facts constituting good cause for the extension sought, and that plaintiff has failed to explain why it did not serve its first discovery requests until the last day of discovery as reset. Accordingly, defendant asks that the Board deny plaintiff's motion to extend discovery, find that the second set of discovery requests, which plaintiff served on April 9, 2003, is untimely and that defendant need not respond thereto, and maintain the discovery and trial schedule as last reset.

¹ The Board notes that plaintiff's motion (filed March 18, 2003) to extend discovery in Cancellation No. 40,955 was granted as conceded by the Board in a May 13, 2002 order. Discovery closed in that proceeding on April 18, 2003.

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In reply, plaintiff contends that defendant failed to inform the Board that the parties were also involved in Cancellation No. 40,955, which involves similar issues and was following a similar discovery and trial schedule;² that its attorney was having difficulty in obtaining information from it that was necessary to prepare its discovery requests prior to the close of discovery in Opposition No. 151,445 on March 10, 2003; that one of its attorneys had a serious illness that resulted in the attorney's hospitalization prior to the March 18, 2003 close of discovery in Cancellation No. 40,955; that, while it is "not entirely clear" that its attorneys' illness and hospitalization caused the attorney's difficulty in obtaining information necessary to prepare plaintiff's discovery requests in Opposition No. 151,455, it is reasonable to conclude that it did so cause.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b)(1); *American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 USPQ2d 1313 (TTAB 1992); and TBMP Section 509. A motion to extend must state

² Such contention is not well taken inasmuch as plaintiff did not mention Cancellation No. 40,955 in its filings with regard to Opposition No. 151,445 until its reply brief in connection with its motion to extend the discovery period, which was filed more than four months after the issues had been joined in both proceedings. See TBMP Section 511.

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with particularity the grounds therefor, including detailed facts constituting good cause. See *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999); 4A Charles A. Wright and Arthur R. Miller, *Federal Practice and Procedure*, Section 1165 (1987). Mere delay in initiating discovery does not constitute good cause for an extension of discovery. See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987).

The Board notes that plaintiff, whose request to resume proceedings was granted in the Board's December 2, 2002 order, was only preparing its first set of discovery requests on the last day of the discovery period. Although plaintiff contends that its attorneys were having difficulty obtaining information from it that was necessary to prepare those discovery requests, this contention is unpersuasive. It is well settled that plaintiff and its attorneys share a duty to remain diligent in moving this case forward. See *Williams v. The Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975), *aff'g* 181 USPQ 409 (TTAB 1974).

In addition, the Board is troubled by the wholly different arguments in plaintiff's motions to extend discovery in the above-captioned proceedings. Plaintiff's March 18, 2003 motion to extend discovery in Cancellation No. 40,955, which was granted as conceded on May 13, 2003 and extended discovery in that case to April 18, 2003, explicitly mentions the illness and hospitalization of one

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of its attorneys as a reason for the extension sought, while its March 10, 2003 motion to extend discovery in Opposition No. 121,455 merely indicates a need for additional time to prepare discovery requests. If one of plaintiff's attorneys had indeed become ill prior to the close of discovery in Opposition No. 151,445 and such illness caused the attorney to have difficulty in obtaining information from plaintiff that was necessary to prepare discovery requests, the motion to extend discovery in that case should have said so. Further, plaintiff admits that it is "not entirely clear" that the illness and hospitalization of one of its attorneys was related to the attorney's difficulty in obtaining information necessary to prepare its discovery requests prior to the close of discovery.

Based on the foregoing, the Board cannot conclude that any difficulty in obtaining information necessary to prepare plaintiff's discovery requests prior to the close of discovery in Opposition No. 151,455 was caused by such illness. Rather, the Board must conclude that the attorney at issue became ill after March 10, 2003 and that such illness thus was unrelated to any difficulty in obtaining information necessary to prepare plaintiff's discovery requests prior to the close of discovery. Accordingly, the Board finds that plaintiff merely delayed in seeking to take discovery prior to the close of discovery on March 10, 2003

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in Opposition No. 151,455 and thus has failed to set forth detailed facts establishing show good cause to extend discovery in that case.

In view thereof, plaintiff's motion to extend discovery in Opposition No. 151,445 is hereby denied. Discovery is deemed to have closed in that case on March 10, 2003.³ Accordingly, the second set of discovery requests that plaintiff served on April 9, 2003 in that case is untimely, and defendant need not respond thereto.

The Board, by its own initiative, hereby orders the consolidation of the above-referenced proceedings inasmuch as the parties are the same and the proceedings involve common questions of law or fact. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); TBMP Section 511. In view thereof, Opposition No. 151,445 and Cancellation No. 40,955 are hereby consolidated.⁴

³ As noted *supra*, discovery in Cancellation No. 40,955 closed on April 18, 2003.

⁴ The Board notes that neither party notified the Board that the parties are involved in two pending proceedings before the Board until plaintiff filed its reply brief in connection with its motion to extend discovery in Opposition No. 151,445 on April 24, 2003. Had the parties complied with the Board's orders instituting the above-captioned proceedings, these proceedings would have been consolidated much earlier, and discovery and trial dates would have been reset to follow the same schedule prior to the close of discovery in either case. Further, earlier consolidation would have reduced the amount of time and resources that the Board has already devoted to the separate proceedings.

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The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board filed will be maintained in Opposition No. 151,445 as the "parent" case. As a general rule, from this point on, only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

In view of the fact that the Board did not issue its decision on plaintiff's motion to extend discovery in Opposition No. 151,445 until after plaintiff's testimony period had been scheduled to commence in that case, trial

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dates in the consolidated proceedings are hereby reset as follows:⁵

Plaintiff's 30-day testimony period to close: **8/15/03**

Defendant's 30-day testimony period to close: **10/14/03**

15-day rebuttal testimony period to close: **11/28/03**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁵ Accordingly, plaintiff's motions to extend testimony periods are moot. Nonetheless, the Board notes that applicant did not consent to either motion, and that both motions contain proposed trial dates. Proposed dates should not be included in unconsented motions to extend. The better practice is to request an extension of a specific length to run from the mailing date of the Board's decision thereon. See TBMP Section 509.02.